

REMARKS

This amendment is in response to the Office Action mailed on January 25, 2005 in which claims 1-6 and 8-22 were rejected. With this amendment, claim 18 is amended and claims 4, 12, and 15 are canceled. Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

I. Claim Objections

In section 1 of the Office Action, the Examiner objected to claims 4, 12 and 15 under 37 CFR 1.75(c) for being of improper dependent form. With this Amendment, claims 4, 12, and 15 are canceled. Accordingly, Applicants respectfully request that the objection to the claims be removed.

II. Rejection of Claims 8 and 12-17 under 35 U.S.C. § 102(b)

In section 3 of the Office Action, the Examiner rejected claims 8 and 12-17 as anticipated by Dallas (5,916,277). Applicants respectfully traverse the rejection.

Claim 8 recites “a means for biasing the flashlight into the open position coupled between the handle and the flashlight.” One such means for biasing is disclosed in the application at paragraph [0021]. The Examiner asserts that element 34 shown in the drawings of the Dallas patent is “a means for biasing the flashlight into the open position coupled between the handle and the flashlight.” However, element 34 is referred to as a “pin” and does not bias the flashlight into the open position. No other structure disclosed in the Dallas patent biases the flashlight into the open position. Accordingly, the Dallas patent does not disclose all the elements of claim 8, and claim 8 and corresponding dependent claims 12-17 are not anticipated by the Dallas patent. Applicants respectfully present independent claim 8 and corresponding dependent claims 12-17 for reconsideration and allowance.

III. Rejection of Claims 1-6, 9-10, and 18-22 Under 35 U.S.C. 103(a)

In section 5 of the Office Action, the Examiner rejected claims 1-6, 9-10 and 18-22 as unpatentable over Dallas (5,916,277) in view of Landamia (6,099,141). Applicants respectfully traverse the rejection.

A. Rejection of Claims 1-6

Claim 1 recites an ancillary tool and a flashlight coupled to the same handle, wherein “the first light source lights the ancillary tool when the flashlight is in an open position.” The flashlight disclosed by Landamia does not light a tool that is coupled to a flashlight. The Examiner states that the light source of Landamia “is capable of lighting the ancillary tool.” However, claim 1 recites that the first light source lights an ancillary tool that is coupled to the handle. In order to establish a *prima facie* obviousness rejection, each of the claim limitations must be disclosed in the cited art and Applicants respectfully assert that Landamia does not specifically teach lighting an ancillary tool that is coupled to the handle of the Landamia device.

Further, even if all the elements of claim 1 were disclosed by a combination of Dallas and Landamia, neither reference provides a motivation to combine the elements disclosed in Dallas with the elements disclosed in Landamia. The Examiner states that “it would have been obvious to one of ordinary skill in the art, at the time the of the invention, to have provided Dallas with an additional LED light source . . . for additional illumination capabilities.” However, Applicants respectfully assert that neither Dallas, nor Landamia provide such a motivation. Dallas does not disclose a second light source, and as such, does not provide motivation for adding a second light source for additional illumination. Landamia discloses an additional light source, however, Landamia does not do so to provide additional illumination. Rather, the additional light source serves a warning light or beacon. See col. 3, lines 27-30.

Further still, Landamia teaches a flashlight including a support device that is configured to allow the flashlight to be self supporting in hands free use to light a separate ancillary tool. Accordingly, Landamia teaches away from combining the flashlight of

Landamia with the handheld tool of Dallas to provide the pocket tool of claim 1 because the pocket tool of claim 1 provides a flashlight and an ancillary tool that are part of a single unit.

Accordingly, claim 1 is patentable over Dallas in view of Landamia. Applicants respectfully request reconsideration and allowance of independent claim 1 and corresponding dependent claims 2-3 and 5-6.

B. Rejection of Claims 18-22

Claim 18, as amended, recites “a means for activating the flashlight, wherein when the means for activating the flashlight is engaged, a means for biasing the flashlight moves the flashlight from a closed position to an open position and the flashlight is turned on.” The Examiner asserts that such means are disclosed in Dallas, specifically at column 4, lines 20-28. However, Applicants respectfully assert that no structure in Dallas serves to bias the flashlight from the closed position to the open position. Further, the structure disclosed in Dallas for activating the flashlight does not engage any structure for moving the flashlight from a closed position to an open position when the flashlight is turned on. Landamia does not overcome the deficiencies of Dallas because, like Dallas, it does not disclose a means for activating the flashlight, wherein when the means for activating the flashlight is engaged, the means for biasing the flashlight moves the flashlight from the closed position to the open position and the flashlight is turned on. In contrast, Dallas discloses a flashlight pivotally coupled to the handle by a pin. No structure disclosed in Dallas or Landamia biases the flashlight into an open position.

Accordingly, claim 18 is patentable over Dallas in view of Landamia. Applicants respectfully request reconsideration and allowance of independent claim 18 and corresponding dependent claims 19-22.

C. Rejection of Claims 9-10

Claims 9 and 10 depend from and include all the elements and limitations of claim 8. As stated above, Dallas does not disclose a means for biasing the flashlight into the open position as recited in claim 8. Landamia does not overcome the deficiencies of Dallas.

because, like Dallas, it does not disclose a means for biasing the flashlight into the open position. Accordingly, claims 9-10 are patentable over Dallas in view of Landamia. Applicants respectfully request reconsideration and allowance of dependent claims 9-10.

IV. Amendment to Claim 18

Applicants have amended claim 18 to provide proper antecedent basis for elements recited in the claim. Applicants assert that the scope of claim 18 is not changed by this amendment.

CONCLUSION

Claims 1-6 and 8-22 are pending in the present application. Claim 18 is amended and claims 4, 12, and 15 are canceled. Applicants believe that the present application is now in condition for allowance. Entry of the amendment and favorable reconsideration of the application, as amended, is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

Date 3/23/05

By 

FOLEY & LARDNER LLP
Customer Number: 26371
Telephone: (414) 297-5897
Facsimile: (414) 297-4900

Jeffrey S. Gundersen
Attorney for Applicant
Registration No. 47,619